REMARKS

Claims 1-10, 12, 15, 16, 22-34 and 42-44 have been cancelled without prejudice, and claims 45-54 have been added. No new matter has been added by virtue of the amendments. For instance, support for the new claims appears e.g. at page 16 and the original claims of the application.

Claims 6-9, 12, 15 and 16 were rejected under 35 U.S.C. 112, second paragraph. As grounds for the rejection, it is noted that former claim 6 recites "about" and that claim 12 is dependent on a cancelled claim.

It is believed the rejection is obviated by the new claims presented herein. The new claims do not include the objected-to term "about". The claim dependencies are appropriate.

In view thereof, reconsideration and withdrawal of the rejection are requested.

Claims 1-5, 12, 15, 16, 22-26, 32-34 and 42-44 were rejected under 35 U.S.C. 102 over Faller et al. (WO 99/40883). The rejection is traversed.

While Applicants disagree with the rejection, it is also believed the rejection is rendered moot by the new claims. In particular, new claim 45 (the only pending independent claim) recites subject matter of former claim 6, which was not rejected under Section 102.

In view thereof, withdrawal of the rejection is requested.

Claims 1-10, 12, 15-16, 22-34 and 42-44 were rejected under 35 U.S.C. 103 over Herron (U.S. Patent 4,764,521) in view of Rubenstein et al. and Welchter (U.S. Patent 5,981,592). As grounds for the rejection, the following is stated as page 4 of the Office Action (emphasis added):

> A person of ordinary skill in the art would have been motivated to employ 4-phenyl-trans-3-butenoic acid for treating cystic fibrosis because aryl carboxylic acids, with substituent or without substituent on the aryl ring, and wherein the carboxyl group attached to the aryl group through either alkyl or alkenyl, are generally known to be useful for treating cystic fibrosis. **The instant compound differing from the prior art compound only in the substituent on the aryl ring, or the double bond at the linker between the aryl and carboxylic group, would have been reasonably expected to be similarly useful for treating cystic fibrosis, absent evidence to the contrary.**

The rejection is traversed.

The Rubenstein documents reports a single compound which is not within Applicants' claims.

The Herron and Welchter documents are apparently cited for the reported broad generic disclosures. No specific compounds identified in Herron and Welchter fall within Applicants' claims.

Such generic disclosures can not sustain the instant rejection. For example, in *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992) (copy enclosed), the Federal Circuit Court of Appeals reversed a rejection under Section 103 and stated (p. 1943),

> We decline to extract from Merck the rule that the Solicitor appears to suggest -- that regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it ... [In the present case, though the reference patent] discloses the potentially infinite genus of substituted ammonium salts of dicamba, and lists several such salts, the salt claimed here is not specifically disclosed. Nor as we have explained above, is the claimed salt sufficiently similar in structure to those specifically disclosed in [the reference patent] as to render it prima facie obvious.

As was the case in *In re Jones*, none of the cited document report any compounds with sufficient structural similarity to the compound recited in Applicants' claims to support a rejection under Section 103. Much greater structural similarity to prior art compounds has been required to support a *prima facie* case under Section 103, as was made clear in *In re Grabiak*, 226 USPQ 870, where the Federal Circuit reversed a Section 103 rejection, finding that a prior

art disclosure of a compound with an **ester** moiety (i.e., $C(O)-OC_2H_5$) did not present a *prima facie* case with respect to Applicant's claimed compound that included a **thioester** moiety (i.e., -C(O)-SR, where R could be C_{1-5} alkyl). The Federal Circuit specifically noted (page 872):

> The PTO cited no pertinent reference showing or suggesting to one of ordinary skill in the art the change of a thioester for an ester group. In the absence of such reference, there if inadequate support for the PTO's position that this modification would *prima facie* have been obvious.
>
> * * *
>
> [T]he Board held that "it is not inconceivable to substitute [sulfur for oxygen] to obtain compounds having the same expected properties." We agree that it is not inconceivable. The standard, however, is whether it would have been obvious in terms of section 103.

Moreover, while Applicants fully believe that a *prima facie* case of obviousness is not presented by the art of record, Applicants also direct the Examiner's attention to the results of Examples 4-9 disclosed at pages 53-54 of the application, where results are disclosed for 4-phenyl-Δ3-transbutenoic acid.

In view thereof, reconsideration and withdrawal of the rejection are requested.

Claims 6-10 and 27-31 were rejected under 35 U.S.C. 103 over Faller et al. (WO 99/40883). As grounds for the rejection, the position is taken that Faller et al. reports "structural homologs" to compounds recited in Applicants' claims. It is acknowledged that the Faller document does not disclose specific compounds of the present application. The rejection is traversed.

For reasons discussed above in response to the prior rejection, this rejection also is properly withdrawn.

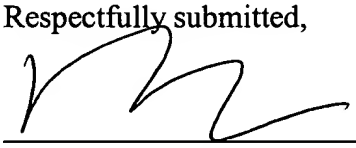
That is, none of the specific compounds reported in Faller et al. fall within Applicants' claims. The broad generic report of Faller also is not sufficient to sustain the instant rejection. See, for instance, *In re Jones*, *supra*.

Further, attention is again directed to the results set forth in the examples of the application, including results for 4-phenyl-Δ3-transbutenoic acid.

In view thereof, reconsideration and withdrawal of the rejection is requested.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



Peter Corless (Reg. No. 33,860)
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, MA 02205
Telephone: 617-439-4444

Customer No. 21874